



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,355	03/09/2001	Yuri Basin	0009785-0125	4202

20572 7590 04/25/2003

GODFREY & KAHN S.C.  
780 NORTH WATER STREET  
MILWAUKEE, WI 53202

EXAMINER

COBY, FRANTZ

ART UNIT	PAPER NUMBER
----------	--------------

2171

DATE MAILED: 04/25/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

SL

# Office Action Summary

Application No.

09/803,355

Applicant(s)

Basin et al.

Examiner

Frantz Coby

Art Unit

2171



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 9, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) NONE is/are withdrawn from consideration.
- 5) ☒ Claim(s) NONE is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) NONE is/are objected to.
- 8) ☒ Claims NONE are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

Art Unit: 2171

This is in response to application filed on March 09, 2001 in which claims 1-18 are presented for examination.

**Claim Status**

Claims 1-18 are pending.

***Information Disclosure Statement***

1. The information disclosure statement filed on July 20, 2001 is in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file, and the information referred to therein has been considered as to the merits.

***Priority***

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78(a)(2) and (a)(5)). Appropriate correction is required.

***Specification***

2. The disclosure is objected to because of the following informalities: the recitation in page 1, line 9 "almost any file one downloads....." should have been ---almost any file *once* downloads.....---

Appropriate correction is required.

Art Unit: 2171

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-5, 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano et al. U.S. Patent no. 5,956,733.

As per claim 1, Nakano et al. disclose the invention including a system for manipulating computer archive files (See Nakano et al. Figure 4). In particular, Nakano et al. disclose the claimed limitations "a user interface" as a protocol interface (See Nakano et al. Figure 7, component 32). Further, Nakano et al. disclose the claimed feature "a file manager including the central directory interfacing with archive files and data object files" (See Nakano et al. Abstract;

Art Unit: 2171

Col. 8, lines 41-51). Also, Nakano et al. disclose the claimed feature “a compression extraction engine interfacing with the file manager for compressing, extracting, encrypting archive files and data object files” as a compressing module (See Nakano et al. Figure 4, component 21).

It is noted, that Nakano et al. did not specifically detail whether its user interface is integrated with Microsoft Windows Explorer as recited in the instant claim 1. However, “Microsoft Windows Explorer” is a registered trademark of Microsoft Corporation and is well known in the art as a utility in Windows that enables users to locate and open files and folders.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have integrated the user interface of Nakano et al. with “Microsoft Windows explorer” because that would permitted management of archive files in Nakano et al. to be achieved more efficiently. Thus, users would be able to select folders from a list displayed on the left side of the screen and access files in a selected folder from a list displayed on the right side of the screen.

As per claim 2, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In addition Nakano et al. disclose “a graphical user interface, a shell and a call level interface” through a menu window (See Nakano et al. Figure 8, component 46). which displays a archiver menu and a plurality of icons (See Nakano et al. Figure 8, components 48, 50 and 52). Notice that a shell is a piece of software that provides communication between the user and the operating system.

Art Unit: 2171

Therefore, since communication is provided between the user interface of Nakano et al. and the operating system, the claimed feature of “the user interface includes a shell” is clearly met by Nakano et al.

As per claim 3, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In addition, as the claimed limitations “the file manager includes the central directory which holds the archived files” (See Nakano et al. Col. 11, lines 54-58).

As per claim 4, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In addition, Nakano et al. disclose the claimed feature of “the compression/extraction engine includes compression and extraction algorithms” as an algorithm of the compression module 21 (See Nakano et al. Col. 8, lines 41-63).

As per claim 5, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above.

It is noted, that Nakano et al. did not specifically detail whether its file manager and compression/extraction engine are integrated into Microsoft Windows Explorer as recited in the instant claim 5. However, “Microsoft Windows Explorer” is a registered trademark of

Art Unit: 2171

Microsoft Corporation and is well known in the art as a utility in Windows that enables users to locate and open files and folders.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have integrated the file manager and compression/extraction engine of Nakano et al. Into "Microsoft Windows explorer" because that would have permitted management and compression of archive files in Nakano et al. to be achieved more efficiently. Thus, users would be able to select folders from a list displayed on the left side of the screen and access files in a selected folder from a list displayed on the right side of the screen.

As per claim 12, all the limitations of this claim have been noted in the rejection of claim

1. It is therefore rejected as set forth above.

As per claims 13-17, most of the limitations of this claim have been noted in the rejection of claim 12. Applicant's attention is directed to the rejection of claim 12 above. In addition, Nakano et al. disclose the claimed features of "opening and viewing contents of archive files"; creating a new archive file"; "modifying an existing archive file"; "extracting archive files" and "encrypting archive files" (See Nakano et al. Col. 2, line 24 through col. 6, line 23).

5. Claims 6-11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano et al. U.S. Patent no. 5,956,733 in view of Japanese Patent 09223052A.

Art Unit: 2171

As per claim 6, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above.

It is noted however, Nakano et al. did not specifically detail the claimed feature of "a mail attachment compressor module for automatically compressing e-mail attachments" as recited in the instant claim 6. On the other hand, Japanese Patent 09223052 achieved the aforementioned claimed feature by providing an electronic mail apparatus including a controller which regulates the transmission and reception of electronic mail where files are compressed through the execution of the compression program (See Japanese Patent 09223052 Attached Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the network archiver system of Nakano et al. wherein the compressing module provided therein (See Nakano et al. Figure 4, component 21) would have incorporated the e-mail apparatus of Japanese Patent 09223052. The motivation being to have enable reliable and easy repeated use of file data in which compression transmission is performed. Thus improved efficiency of data transmission and reception since file data are compressed by optimum method.

As per claims 7-11, most of the limitations of these claims have been noted in the rejection of claim 6. Applicant's attention is directed to the rejection of claim 6 above.

It is noted, that neither Nakano et al, nor the Japanese Patent 09223052 specifically detail whether to integrate or implement an e-mail attachment with Microsoft Outlook as recited in the



Art Unit: 2171

instant claims 7-11. However, "Microsoft Outlook" is a registered trademark of Microsoft Corporation and is well known in the art as a utility in Windows that enables users to exchange text messages and computer files over a communications network..

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have integrated the e-mail apparatus of the Japanese Patent 09223052 with "Microsoft Outlook" because that would have improved efficiency of data transmission and reception since file data are compressed by optimum method.

As per claim 18, most of the limitations of this claim have been noted in the rejection of claim 12. Applicant's attention is directed to the rejection of claim 12 above.

It is noted however, Nakano et al. did not specifically detail the claimed feature of "installing a mail attachment compressor module onto a user's computer" as recited in the instant claim 18. On the other hand, Japanese Patent 09223052 achieved the aforementioned claimed feature by providing an electronic mail apparatus including a controller which regulates the transmission and reception of electronic mail where files are compressed through the execution of the compression program (See Japanese Patent 09223052 Attached Abstract). As to the claimed feature of "initiating Microsoft Outlook", "Microsoft Outlook" is a registered trademark of Microsoft Corporation and is well known in the art as a utility in Windows that enables users to exchange text messages and computer files over a communications network.

Art Unit: 2171

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the network archiver system of Nakano et al. wherein the compressing module provided therein (See Nakano et al. Figure 4, component 21) would have incorporated the e-mail apparatus of Japanese Patent 09223052. The motivation being to have enable reliable and easy repeated use of file data in which compression transmission is performed. Thus improved efficiency of data transmission and reception since file data are compressed by optimum method. Also, it would have been obvious to one of ordinary skill in the art at the time of the invention to have integrated the e-mail apparatus of the Japanese Patent 09223052 with "Microsoft Outlook" because that would have improved efficiency of data transmission and reception since file data are compressed by optimum method.

***Conclusion***

**Any response to this action should be mailed to:**

Commissioner of Patents and trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 305-9051, (for formal communications  
intended for entry)

**Or:**

(703) 308-5357 (for informal of draft

Art Unit: 2171

communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington.

VA., Sixth Floor (Receptionist).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is (703) 305-4006. The examiner can normally be reached Monday through Friday from 9:30 A.M. to 5:00 P.M.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-14367. The Fax phone number for this Group is (703) 746-7238; (703) 746-7239; (703) 746-7240.

A handwritten signature in cursive script, reading "Frantz Coby", is written over a horizontal line.

**FRANTZ COBY  
PRIMARY EXAMINER**

*Technology Center 2171*

April 15, 2003